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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,273	11/06/2000	Charles Eric Hunter	IVOO-0145	8435

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EXAMINER	
NGUYEN, CUONG H	

ART UNIT	PAPER NUMBER
3661	

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
09707273	11/6/00	HUNTER ET AL.	IVOO-0145

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CUONG H.. NGUYEN	
ART UNIT	**PAPER**
3661	20070802

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Commissioner for Patents

The initialed copy of the IDS filed on 9/15/2005, and the Examiner's Answer with new sub-headings as required in MPEP 1207.02(A).

CUONG H. NGUYEN
Primary Examiner
Art Unit: 3661

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 20060831

Application Number: 09/707,273
Filing date: 11/06/2000
Appellants: Charles E. Hunter, et al.

Jeremiah J. Baunach (Reg. no. 44,527)
For Appellants

EXAMINER'S ANSWER

This is in response to appellants' brief on appeal filed on 12/26/2006.

(1) Real Party in Interest

A statement identifying the real party in interest (Ochoa Optics LLC) is contained in the brief.

(2) Related Appeals and Interferences

There are other related appeals (S.N. 09/645,087, 09/675,025, 09/684,442, and 11/085,944), besides there is no additional appeal or interference before the Board of Appeals and Interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments

The appellants' statement of the status of amendments contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The examiner agrees with the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellants' statement of the grounds of rejection to be reviewed set forth in the brief is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence relied on:

- Schulhof (US Pat. 5,572,442);
- McMillen et al. (US Pat. 5,483,535).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. The ground(s) for

rejection are provided here for the convenience of both Appellants and the Board of Patent Appeals.

Claim Rejections - 35 USC § 102

9.1. Claims 40-42, 48, 52-54, 60, 62, and 64-71 are rejected under 35 U.S.C. 102(b) as being anticipated by Schulhof et al., (U.S. Pat. 5,572,442).

Schulhof et al. teach a method, a computer medium, and an apparatus for distributing music comprising:

A. As to claims 40-42, 48, 52-54, 60, and 64-70:

- a recording device configured to enable automatic charging of a consumer for a music selection, said charging triggered upon the consumer recording the music selection on a storage medium located in the recording device (see Schulhof et al., the abstract, and Fig.1 ref.24).
- Fig.7 shows a request for available music from a customer (ref.204) and "Info Request Manager" 22 would fulfill that request by transmitting from "Satellite Distribution System" 200.

B. As to claims 50, and 62: In Fig. 7, Schulhof et al. teach about communicating an order of said music selection to a central controller ("Info Request Manager" 22), transferring copies of records of said order to a transmission scheduler (see Schulhof et al., col. 1 lines 64-67); communicating schedules created by said transmission scheduler to a satellite uplink facility for transmission of said order; and transmitting via satellite said order to said customer site.

C. As to claim 71: In Fig. 1, Schulhof et al. teach about a receiving mechanism (A "Portable Storage Medium" 50 coupling to a "Docking Interface Device" 36 for identifying available music.

Claim Rejections - 35 USC § 103

9.2. Claims 49, 51, 61, 63, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulhof et al.

A. Schulhof et al. teach a product/a system/a method of distributing music to customer households comprising a step/or a means of:

- providing each customer household with information identifying available music selections that will be transmitted (see Schulhof et al., the abstract, Figs. 1, 4, and 6; col.5 lines 6-20, lines 50-67; col.7 lines 5-53, and col.9 lines 20-26);

- permitting each customer household to preselect and record desired music selections on a high capacity storage medium (i.e., read/write CDs, magneto-optical disks, or digital tapes .etc. - see Schulhof et al., the abstract, Figs. 1, 4, and 6; col.5 lines 6-20, lines 50-67; col.7 lines 5-53, and col.9 lines 20-26);

- permitting each customer household to playback recorded music selections (see Schulhof et al., Figs. 1, 4, and 6; col.4 lines 48 to col. 5 line 67; col.7 lines 5-53, and col.9 lines 20-26);

- communicating music playback information from each customer household to a central controller system; and billing customer households for the recorded music selections that are made available for playback (see Schulhof et al., col.4 line 48 to col. 5 line 20, col.6 lines 24-52; col. 7 line 54 to col. 8 line 53, col.10 lines 42-65, and col.9 lines 20-26).

B. Re. To claims 51, and 63: Schulhof et al.'s Fig.7 teaches a structural configuration to distribute ordered music.

It would have been obvious to an ordinary skill in the art at the time of invention from Schulhof et al.'s teachings that an order would be done by using a home personal computer, using a cell phone, using a PDA wireless or using a wireless application protocol because those are available means for remote communications between an ordered and a provider.

C. Re. To claims 49, 61, and 72: Schulhof et al.'s Fig.7 teach a structural configuration where a charge/bill to a requester would be applied/sent after transmitting requested music by "Billing/Accnt. Manager" 24.

9.3. Claims 43, 55, 44, 46-47, 56, and 58-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulhof et al. (US 5,572,442), in view of McMillen et al. (US Pat. 5,483,535).

The rationales and reference for a rejection of claim 40 are incorporated.

A. As to claims 43, and 55: Schulhof et al. teach all claimed information in these claims except a peer-to-peer communication network utilizing residential phone lines, modem, and Internet. Schulhof et al. also teach about scheduling a broadcast for the order based upon ordered records.

However, McMillen et al. suggest a use of peer-to-peer communication network for music trans-receiver/sharing (see McMillen et al., the abstract, and the summary).

B. As to claims 44, and 56: McMillen et al. also suggest of using a master-slave serial communications controller and an adapter to enable the interface to operate in a peer-to-peer mode on the network.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Schulhof et al., and McMillen et al. teachings to suggest that product/system/method 's taking place in a peer-to-peer environment because this environment fit with distributing music

among different parties for one copy of requested music: while one device is sending data, there is not another device on the ring sending instead, the data sent by that device goes all the way around the ring and back to the sender.

C. As to claims 46-47, and 58-59: The rationales and reference for a rejection of claim 43 are incorporated.

The examiner respectfully submits that it is merely an intent of use a peer-to-peer network for a well-known management task:

- using a peer-to-peer network (to marking on a catalog if an object is available) as taught by McMillen is not an inventive feature.

- using a peer-to-peer network as taught by McMillen to create a consumer's profile/preference is not an inventive feature.

9.4. Claims 45, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulhof et al. (US 5,572,442)., in view of McMillen et al. (US Pat. 5,483,535).

The rationales and references for a rejection of claim 43 are incorporated.

Schulhof et al., and McMillan may not expressly disclose about placing an highlight, or an icon within a catalog.

However, it is old and well-known of using bookmarks, or flags, or any computer object to get immediate attention of a catalog user for availability/comparison (e.g., using different color flags in a catalog - e.g., Wiecha, US Pat. 5,870,717 teaches of using "compare" icons (with different high-lights in a catalog; Storey US Pat. 6,009,412 teaches of using an icon in the a PRODUCT HOMEPAGE 100A in a catalog; Bruno et al. teach of using an icon in an electronic catalog, US Pat. 6,320,952).

- creating a customer's profile (e.g., Khoyi et al., (US Pat. 5,206,951) teach about creating and using different profiles according to different objects/customer with a profile editor);

- using a cell-phone, or using a Personal Data Assistant (PDA) to order; or ordering via wireless application protocol (WAP) has been known different wireless communication means for ordering.

- It would have been obvious to one of ordinary skill in the art at the time of invention to combine Schulhof et al., and McMillen et al., and the above well-known applications to suggest that product/system/method using available notifying (e.g., icon objects) and creating different profiles for an efficient task of operating a music distribution system.

(10) Response to Argument:

The examiner respectfully submits that applicants are claiming an apparatus in pending claims 64-72; therefore, any claiming of functional language should then be limited to an apparatus as to opposed to a process or method (a "use" can only be claimed by claiming the use as a process. See *In re Papesch*, 315 F.2d 381, 384, 137 USPQ 1084, 1088 (CCPA 1963). Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). When interpreting functional language, if the prior art is capable of performing the claimed function "even if not directly disclosed", it anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997)). Because the claim 52 is directed to a computer readable medium having computer instructions stored thereon for performing the method of claim 40 (please note that these instructions are not submitted/disclosed); the examiner respectfully

submits that at most, it claims a well-known structure that contain "a method" as describing in claim 40.

11. The examiner respectfully disagrees about a critical assertion on page 4, that "Schulhof does not disclose the subject matter of claim 40".

A. Re. to pending claim 40: A method comprising:

automatically charging a consumer for a music selection made by the consumer, said charging triggered upon the consumer recording the music selection on a storage medium located at a consumer site.

Since this is a very well-known concept about "a fair transaction" the examiner pays more attentions to "a charging triggered upon a consumer recording a music selection"; the examiner could not find any explaining of how "trigger" or equivalent meanings for that term in the specification (to support for "charging" as argued in para.7 of page 4, and on page 5, para. 2-3, and 6); therefore, at most it is considered as said charging is activated when a consumer recording/downloading a music selection - this is inherently taught by Schulhof, i.e. the charge is authorized by the user, (see Schulhof, Fig.6 ref.24, and col.5 lines 5-17), a download is performed (as in a pay-per-view system, see Schulhof, col.5, lines 14-15, and col.6 lines 42-45), , and monthly billing by cable companies for regular service, and pay per view services (after the viewing) are inherent to the cable system taught by Schulhof.

B. For claims 41-57, and 60-72; the applicants argue similar reasons as above for (i.e., "*triggered upon the consumer recording the music selection on a storage medium located at a consumer site*"; the examiner respectfully submits Schulhof inherently teaches that idea as evidences shown above.

The claimed language of "charging triggered upon ... recording" also does not define a time duration to charge; it may means that a customer eventually would be charged for recording music; the examiner respectfully submits that this meanings is inherent in Schulhof et al.*(please note that "triggered upon" is not in the submitted specification).*

The claimed language of "charging triggered upon ... recording" does not define a time duration to charge; its relative meanings is that a customer will be charged for recording music; the examiner respectfully submits that this meanings is inherent in Schulhof et al.

Applicants claim a method that *charging a consumer when he downloads/records a song; the examiner respectfully submits that cited reference of Schulhof et al. is inherently included this idea (charging- at ordering time, or at downloading time - a customer for an order)*

The order of a product can be made by physically mailing or by downloading; with physically mailing, a product is charged when ordering is placed; with downloading, a song is charged at the time of order – note that a VISA/MASTER account must be verified before a transaction is made, even applicants argue that "charging triggered upon the consumer recording the music selection" *the required processing time must be taken into account even if arguing that time is small. In other words, an order is often be charged at the time of placing it – if it is available, a customer will download it "immediately" this mostly happens; therefore, the claimed idea is inherently included in Schulhof et al. reference (please note that this concept is further narrows* in pending claim 64 "a billing mechanism configured to bill the consumer for each record music selection that is made available for playback." *– this has been widely practiced).*

C. For claim 43; the applicants argue

For claims 41-57, and 60-72; the applicants argue that "There is no description in McMillen of a "music selection" using a peer-to-peer network; and nor of "informing the consumer that selection is available" – these features are suggested by cited evidences in Final Office Action (a selection was done by Schulhof, and McMillen taught that selection can be distributed with a peer-to-peer network; about "informing the consumer that selection is available" is suggested by Schulhof as teaching of interactive communication abilities.

D. It is reasonable that a modification of Schulhof's invention would be apparent to those skilled in the art at the time of invention without departing from the scope and spirit of that invention because this application mainly claim the required "a fair transaction" in order to perform interactive communication between 2 parties, then downloading/recording a selection. Although cited references may be described in connection with specific preferred embodiments, it should be understood that their limitations as disclosed should not be limited to such specific embodiments.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Cuonghnguyen

Cuong H. Nguyen

Serial Number: 09/707,273
Art Unit 3661

An appeal conference was held on August 31, 2006 with:

SPE Thomas Black, Art Unit 3661

Primary Examiner Thomas Dixon, Art Unit 3639

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